

of "polypropylene" (appellant's remarks, page 8 line 11). Hence, appellant is also apparently acknowledging that the Whiteford reference discloses appellant's claimed invention. Accordingly, appellant's position that Whiteford does not disclose applicant's specific structure is contradicted by appellant's remarks concerning the Whiteford reference.

Appellant apparently is relying upon the intended use language in the claims for patentability. Appellant states:

"There is no disclosure or suggestion in that reference of the use of planar support sheets applied to a planar support surface to permit the cutting of vegetables and the like without cutting the underlying surface."

(Appellant's Brief, page 9, lines 14-17; emphasis added)

First, <sup>18</sup>appellant's position that patentable weight should be given to such intended use is clearly in error. The position of the C.C.P.A. on the subject of intended use is in no way equivocal. This is evidenced by the following propositions:

"Manner or method in which machine is to be utilized is not germane to issue of patentability of machine itself."

(In re Casey 152 U.S.P.Q. 235; emphasis added)

and "Introduction phrase...is merely a statement of intended use and does not qualify or distinguish structural apparatus claimed over reference."

(In re Sinex, 135 U.S.P.Q. 302; emphasis added)

Clearly, the various recitations in the claims of intended use have no patentable significance.

Secondly, the Whiteford reference does disclose appellant's intended use. Whiteford unequivocally does



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**GROUP 320**

[ Serial No. 287,141 07/27/81 ]  
Marian E. Gillett

Before the Board of Appeals

Freling E. Baker  
110 W. C Street, Ste. 1305  
San Diego, California 92101

Freling E. Baker  
For Appellant

Examiner's Answer

This is an appeal from the final rejection of  
claims 4-6 and 11.

A correct copy of the appealed claims appears  
on page 2 of the appellant's brief.

THE INVENTION

The invention is adequately described on page  
3 of appellant's brief.

THE REFERENCES OF RECORD RELIED ON

3,305,124	Whiteford	2/21/67
3,811,989	Hearn	5/21/74

THE REJECTION

The amendment filed November 18, 1982  
amending page 2, line 25 was objected to under 35 USC  
132 because it introduced new matter into the  
specification. 35 USC 132 states that no amendment  
shall introduce new matter into the disclosure of the  
invention. The added material which is not supported  
by the original disclosure is as follows: "non

apply a planar support sheet to the bottom of the tray recesses to permit the cutting of vegetables and the like without cutting the underlying surface of the tray. Furthermore, inasmuch as Whiteford discloses the sheet as being "flexible" (column 2, line 41) it is seen to be capable of being rolled into a funnel shape although this is a matter of intended use that has no patentable significance. Appellant's position that the rim in the Hearn patent is for "decorative" purposes rather than "functional" Purposes (Appellant's Brief, page 10, lines 16-19) indicates further that appellant is again relying on intended use for patentability. Appellant's position in this regard is clearly in error.

#### CONCLUSION

It is respectfully submitted that the specification as originally filed does not provide support for the invention and that the references as applied demonstrate the obviousness of the subject matter recited in the appealed claims and that the final rejections under 35 USC 112 and 35 USC 103 were proper and should be sustained.

RC Watson:klw  
7-29-83  
(703) 557-3357

ROBERT C. WATSON  
EXAMINER  
ART UNIT 223